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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,697	12/12/2000	Noel Lee	P1230	6750

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EXAMINER

POLK, SHARON A

ART UNIT PAPER NUMBER

2836

DATE MAILED: 05/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/735,697

Applicant(s)

LEE, NOEL

Examiner

Sharon Polk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 09221761.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 6) ☒ Other: *OACS console*.

DETAILED ACTION

1. In response to Appellant's representative suggesting that the Examiner has falsified documents (Appellant's Brief, page 30, lines 38-39, and page 31, lines 1-7). It is customary practice to generate interview summaries contemporaneously with or immediately after the interview. It is further customary practice, within this art unit, to mail out the interview summary with the next office action. This was done in this case. This must have lead to Applicant's confusion regarding never having received an interview summary.

2. 'In view of the appeal brief filed on February 8, 2002, PROSECUTION IS HEREBY REOPENED. A new ground of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Response to Arguments

3. Appellant's arguments with respect to claims 29-40 have been considered but are moot in view of the new ground(s) of rejection.

It was argued that the Kensington reference does not render unpatentable the present invention. This point is moot because the Kensington reference is no longer being applied. Furthermore, any declarations, antedating evidence relating to this reference are no longer applicable.

It was argued that the '718 patent does not teach, suggest, nor motivate the recitations of claims 30-40, and further that the examiner grounds of rejection involve impermissible hindsight construction. A new art rejection follows to address these arguments.

It was argued that the '718 patent does not teach, suggest, nor motivate the recitations of claim 29, and further that the examiner grounds of rejection involve impermissible hindsight construction. A new art rejection follows to address these arguments.

It was argued that the evidence of secondary considerations be reconsidered. However the only relevant declaration is that of Karen Johnson. In reconsidering Ms. Johnson's declaration, the examiner has established as a matter of fact the it is

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deficient for several reasons: first, the declaration does not identify the relevant market, second, the declaration does not identify what share of the market is being catered to, third, the declaration does not state if the market is highly competitive, fourth, the declaration does not state how easily accessible the market can be entered into, fifth, the declaration does not state how long it took to establish the market, sixth, the declaration does not state if the "unidentified" market, was an existing old market purchasing the new and improved product, and seventh, the declaration does not state what embodiment of the claimed invention is being sold. Therefore, as previously stated, the provided declaration under CFR §1.132, of Karen Johnson is deficient, and thus not sufficient to outweigh the evidence of obviousness provided below.

It was argued that Kensington, in view of Sunabe does not teach, suggest, nor motivate the recitations of claims 30-40, and further that the examiner grounds of rejection involve impermissible hindsight construction. As previously indicated, the Kensington reference is not being applied, and a new art rejection follows to address these arguments.

It was argued that the '718 Patent, in view of Barna, and even further in view of Sunabe does not teach, suggest, nor

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motivate the recitations of claims 30-40. A new art rejection follows to address these arguments.

It was argued that the '718 Patent merely describes red stripes and rings applied to a power line conditioner. When in fact the '718 Patent discloses that the power line conditioner is a "standard power strip which has evolved into what is commonly termed a 'power line conditioner'. . ." (col. 1, lines 38-40).

It was argued that the Examiner improperly used official notice. This argument is moot, because official is not relied upon in the forthcoming art rejection.

It was argued that common assignee matters should be considered by the Patent Office when determining patentability under 35 USC § 103 (c). This argument is moot because the Kensington reference is no longer being relied upon.

It was argued that the '718 Patent should be disqualified under 35 USC § 103 (c). Because the '718 Patent is a **valid** 35 USC § 102(b) reference, as such, 35 USC § 103 (c) does not apply.

It was alleged that the examiner has prejudged the instant case, and further that the Appellant's attorney takes great exception to the Examiner's characterization of the "statement of facts" as being inaccurate. However, so as not to further

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detract from the merits of this case, the examiner chooses not to respond.

The examiner notes that a copy of the interview summary dated May 10, 2000, has been attached as well as the document indicating the date and time of the creation of the interview summary. Further, the examiner invites applicant to review advisory action, (paper no. 8), of then co-pending application 09/221,761 to view the a copy of the **same** interview summary that is attached.

Specification

4. The specification is objected to for lack of compliance with MPEP § 1.71 which requires the specification to [must] include a written description of the invention . . . and the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same.

The disclosure of the indicia does not comply with § 1.71. In particular, page 3, lines 20-24, of Appellant's original disclosure, indicia elements are defined as an adhesive-backing type label having a color that matches the color of the power cord and the corresponding color of the AC outlet housing portion. The indicia elements are further defined as also

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comprising identifying information about the peripheral device to be powered. It is noted, on page 6, lines 19-20, in Appellant's discussion of after market that appropriate colored labels **or** indicia may be applied to the AC outlet portions. Appellant then redefines indicia, lines 24-26, **may** include the identifying information of a particular peripheral device to be powered. By example, indicia with the appropriate peripheral device . . . may be imprinted on the indicia.

Are the indicia elements colored labels, labels with identifying information, or colored labels with colored imprinted identifying information?

It appears as though the Appellant would like for indicia to be at least two of scenarios posed by the examiner. However, when Appellant later recites that "**labels or indicia**" may be applied, the definition becomes cloudy, because labels as understood, are indicia. Furthermore, as indicated the indicia elements comprise identifying information . . . Yet Appellant recites that the indicia **may** include identifying information. Do the labels *always comprise* identifying information as disclosed? If not, how is one able to discern when it is applicable and when it is not?

Appellant should use consistent terminology throughout the specification to avoid confusion. Appellant should use clear,

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concise, and **exact** terms when describing the indicia elements, or the embodiments thereof.

Applicant may choose to submit an additional drawing, to depict imprinted identifying information, so as not to warrant a claimed subject matter not shown drawing objection. This, of course would only be applicable if Appellant amends the claims to clearly claim this feature.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33-36, 39-40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 33 is not enabling because it recites solid color stickers and color coded indicia as two elements to be applied. Yet, the specification enables one element to be applied.

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6. The following is a quotation of the second paragraph of 35

U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 37-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 37 and 39 recited "for selective attachment." It is unclear if the selection is referring to the selecting the color of the sticker, or selecting one of the two devices later recited.

Method claim 38 is vague and indefinite for several reasons: First, Applicant recites a method of providing AC power to a plurality of peripheral devices by color-coding. The examiner notes that color-coding has nothing to do with providing AC power to a plurality of peripheral devices.

Second, an AC electrical strip is provided which [has] a plurality of color coded indicia (lines 3-4), yet a housing member is claimed also having a plurality of discrete, solid colored areas (lines 10-11). What is the difference between the claimed AC electrical power strip, and the claimed housing?

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Third, an indicia element is provided on each solid colored area (line 19). As discussed above, what is the indicia element? Is this the third indicia element being provided to the same location?

Claim Rejections - '35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 29 and 31 are rejected under 35 U.S.C. 102(b) as being by clearly anticipated by Lee, (US 5,589,718).

Lee discloses an AC electrical power strip (col. 1, lines 38-40) apparatus having a plurality of color coded indicia (col. 3, lines 37-41) for a plurality of electrical outlets (Figure & 16a-16h) thereon for associating a plurality of peripheral devices coupled thereto (col. 2, lines 54-55), said apparatus comprising:

an input power cord member (14) ;

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an electrical distribution main electrically coupled to said input power cord member and to said plurality of electrical outlets (col. 2, lines 55-58); and

a housing member (12) for housing said distribution main and said outlets (16a-16h), and for securing said power cord member (14) to said main, said housing also having a plurality of discrete (Figure), solid colored areas, each said discrete solid colored area being disposed on and surrounding each outlet of said plurality of outlets for associating said each outlet of said plurality of outlets with a particular color, and for associating each outlet of said plurality of outlets with each peripheral device of said plurality of peripheral devices. (Col. 3, lines 43-50).

With regard to claim 31, Lee further discloses:

a plurality of solid colored electrical extension cords, for selective attachment to said power strip apparatus (col. 3, lines 50-col. 4, lines 3),

each colored electrical extension cord of said plurality of solid colored electrical extension cords being a color distinct from any other solid colored electrical extension cord in said plurality of solid colored electrical extension cords (col. 4, lines 3-6),

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each solid colored electrical extension cord being selected such that its color matches the color of the solid colored area being utilized (col. 3, lines 41-43).

The following art rejection is given as best understood in light of the 35 USC § 112 rejection above.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 30, 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Sunabe (US 5,366,250).

With regard to claim 30 Lee discloses the claimed invention except for:

a plurality of sets of solid colored stickers,
each sticker of said set being selected such that its color matches the solid colored area to be utilized for powering said each peripheral device,

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each said set of solid colored stickers being a color distinct from any other said set of solid colored stickers.

Sunabe teaches:

a plurality of sets of solid colored stickers (Figures 2 and 5, col. 4, lines 44-46),

each said set of solid colored stickers being a color distinct from any other said set of solid colored stickers (col. 4, lines 31-38 and Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lee to include stickers because **Lee discloses** applying red indicia on the cables or on the connectors attached to the cable) (col. 4, lines 1-3) with **Sunabe teaching** the application of color coded indicia (a peelable label) for the purpose of providing a new and improved system for marking electrical wires and wire locations. . . which are simple and reliable and which do not require memory and recall of wiring arrangements. (Col. 2, lines 51-56).

With regard to claim 32 Lee discloses the claimed invention except for:

a plurality of sets of solid colored stickers,

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each sticker of said set being selected such that its color matches the solid colored area to be utilized for powering said each peripheral device,

each said set of solid colored stickers being a color distinct from any other said set of solid colored stickers.

Sunabe teaches:

a plurality of sets of solid colored stickers (Figures 2 and 5, col. 4, lines 44-46),

each said set of solid colored stickers being a color distinct from any other said set of solid colored stickers (col. 4, lines 31-38 and Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lee to include stickers because **Lee discloses** applying red indicia on the cables or on the connectors attached to the cable) (col. 4, lines 1-3) with **Sunabe teaching** the application of color coded indicia (a peelable label) for the purpose of providing a new and improved system for marking electrical wires and wire locations . . . which are simple and reliable and which do not require memory and recall of wiring arrangements. (Col. 2, lines 51-56).

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With regard to claim 37 Lee discloses the claimed invention except for:

a kit, the kit comprising:

a plurality of sets of solid colored stickers.

Sunabe teaches:

a kit (Figures 2 & 5), the kit comprising:

a plurality of sets of solid colored stickers (Figures 2 & 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lee to include a kit because **Lee discloses** that a color-coding scheme could be imparted to the entire audio-visual system including the interconnects that the various component," (col. 3, lines 41-43). The Examiner finds that the "scheme" disclosed in Lee teaches the "kit" recited in the claim. The ordinary meaning of the term "scheme" supports this finding. See Merriam Webster's Collegiate Dictionary, 10 ed., page 1044, © 1997, (defining scheme as "a plan or program of action: a systematic or organized framework: design); with **Sunabe teaching** a kit comprising color coded peelable labels for the purpose of providing a visual pattern system for wiring information which avoids reliance on memory and mental steps in electrical installations. (Col. 2, lines 61-63).

With regard to claim 33 Lee discloses the claimed invention except for:

a plurality of solid colored stickers and;

a plurality of color coded indicia disposed proximately to each outlet of said plurality of outlets for retrofitting said plurality of outlets,

said plurality of solid colored stickers and said plurality of color coded indicia for associating each outlet of said plurality of outlets with a particular color, and for associating each outlet of said plurality of outlets with each device of said plurality of peripheral devices.

Sunabe teaches:

a plurality of solid colored stickers (Figures 2 and 5)and;

a plurality of color coded indicia disposed proximately to each outlet of said plurality of outlets for retrofitting said plurality of outlets (col. 3, lines 23-25 and col. 4, lines 62-65),

said plurality of solid colored stickers and said plurality of color coded indicia for associating each outlet of said plurality of outlets with a particular color (col. 4, lines 32-38).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lee to include the

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discrete areas for receiving a plurality of color coded stickers and the recited color coded indicia because **Lee discloses** (applying red indicia on the cables or on the connectors attached to the cable). The video source components, and the outlet 16e and 16f, would be assigned another color. . . (col. 4, lines 1-5) with **Sunabe teaching** the application of color coded indicia (a peelable label) for the purpose of providing a new and improved system for marking electrical wires and wire locations . . . which are simple and reliable and which do not require memory and recall of wiring arrangements. (Col. 2, lines 51-56).

With regard to claim 34 Lee discloses the claimed invention except for:

a plurality of sets of a plurality of solid colored stickers

each solid colored sticker of said plurality of solid colored stickers of each said set being selected such that its color matches the color of the solid colored sticker provided on the area,

each said set of solid colored stickers being a color distinct from any other said set of solid colored stickers.

Sunabe teaches:

a plurality of sets of a plurality of solid colored stickers (Figures 2 & 5),

each solid colored sticker of said plurality of solid colored stickers of each said set being selected such that its color matches the color of the solid colored sticker provided on the area (Figure 1),

each said set of solid colored stickers being a color distinct from any other said set of solid colored stickers (col. 4, lines 31-38 and Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lee to include the plurality of sets of a plurality of solid colored stickers for the purpose of providing a visual pattern system for wiring information which avoids reliance on memory and mental steps in electrical installations. (Col. 2, lines 61-63).

With regard to claim 35 Lee discloses:

a plurality of solid colored electrical extension cords, for selective attachment to said power strip apparatus (col. 3, lines 50-col. 4, lines 3),

each colored electrical extension cord of said plurality of solid colored electrical extension cords being a color distinct from any other solid colored electrical extension cord in said

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plurality of solid colored electrical extension cords (col. 4, lines 3-6),

each solid colored electrical extension cord being selected such that its color matches the color of the solid colored area being utilized (col. 3, lines 41-43).

With regard to claim 36 Lee discloses the claimed invention except for:

a plurality of sets of a plurality of solid colored stickers

each solid colored sticker of said plurality of solid colored stickers of each said set being selected such that its color matches the color of the solid colored sticker provided on the area,

each said set of solid colored stickers being a color distinct from any other said set of solid colored stickers.

Sunabe teaches:

a plurality of sets of a plurality of solid colored stickers (Figures 2 & 5),

each solid colored sticker of said plurality of solid colored stickers of each said set being selected such that its color matches the color of the solid colored sticker provided on the area (Figure 1),

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each said set of solid colored stickers being a color distinct from any other said set of solid colored stickers (col. 4, lines 31-38 and Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lee to include stickers because **Lee discloses** applying red indicia on the cables or on the connectors attached to the cable) (col. 4, lines 1-3) with **Sunabe teaching** the application of color coded indicia (a peelable label) for the purpose of providing a new and improved system for marking electrical wires and wire locations . . . which are simple and reliable and which do not require memory and recall of wiring arrangements. (Col. 2, lines 51-56).

With regard to claim 39 Lee discloses the claimed invention except for:

a kit, the kit comprising:

a plurality of sets of at least three like solid colored stickers.

Sunabe teaches:

a kit (Figures 2 & 5), the kit comprising:

a plurality of sets at least three like of solid colored stickers (22" & Figure 5).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lee to include a kit because **Lee discloses** that a color-coding scheme could be imparted to the entire audio-visual system including the interconnects that the various component," (col. 3, lines 41-43). The Examiner finds that the "scheme" disclosed in Lee teaches the "kit" recited in the claim. The ordinary meaning of the term "scheme" supports this finding. See Merriam Webster's Collegiate Dictionary, (10 ed., 1997), (defining scheme as "a plan or program of action: a systematic or organized framework: design); with **Sunabe teaching** a kit comprising color coded peelable labels for the purpose of providing a visual pattern system for wiring information which avoids reliance on memory and mental steps in electrical installations. (Col. 2, lines 61-63).

With regard to claim 40 Lee discloses:

a plurality of solid colored electrical extension cords, for selective attachment to said power strip apparatus (col. 3, lines 50-col. 4, lines 3),

each colored electrical extension cord of said plurality of solid colored electrical extension cords being a color distinct from any other solid colored electrical extension cord in said

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plurality of solid colored electrical extension cords (col. 4, lines 3-6),

each solid colored electrical extension cord being selected such that its color matches the color of the solid colored area being utilized (col. 3, lines 41-43).

With regard to method claim 38, Lee as modified by Sunabe teaches the claimed invention. It has already been discussed what is not taught by Lee, and further how Sunabe teaches the deficiencies of Lee to yield the claimed invention. As such, the method is inherently taught by the apparatus.

Communications With The PTO

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Polk whose telephone number is 703-308-6257. The examiner can normally be reached on M-F 7-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on 703-308-3119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7724 for regular communications and 703-305-7723 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

April 29, 2002

Sharon Polk

Patent Examiner - Art Unit 2836



BRIAN SIRCUS
SUPERVISORY PATENT EXAMINER
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